

REMARKS/ARGUMENTS

Specification Objections

The title was objected to for not being descriptive. Applicants have amended the title to correspond to the suggested title by the Examiner.

The priority statement and incorporation by reference statement presented in the Preliminary Amendment submitted with the initial filing of the U.S. National Phase application was not entered into the Specification. The statements are presented again for entry into the Specification. This amendment does not enter New Matter as the statements were in the Preliminary Amendment at the time of filing/

Claim Objections

Claim 5

Claim 5 was objected to for containing a misspelling. Applicants have amended Claim 5 to correctly spell “thiophenyl”.

In light of the foregoing amendment, the Examiner is respectfully requested to allow Claim 5.

Double Patenting

Claims 4 – 6, 17 and 21 – 22

The Office Action has provisionally rejected Claims 4 – 6, 17 and 21 -22 on the ground of nonstatutory obviousness-type double patenting over Claims 1 and 4 – 6 of copending application 10/557,085. These rejections are provisional rejections because no claims have been allowed in either application.

Application No. 10/557,085 is still pending, making this rejection a “provisional” rejection. At this time, therefore, Applicants are not required to file a terminal disclaimer. Applicants therefore request that the Examiner hold this rejection in abeyance and proceed with substantive examination of the Application based upon the prior art. In the event that all prior art rejections are overcome, it is respectfully requested that a Notice of Allowance be immediately issued. *See* MPEP § 804 (stating that “The ‘provisional’ double patenting rejection should continue to be made by the examiner in each

application as long as there are conflicting claims in more than one application unless that ‘provisional’ double patenting rejection is the only rejection remaining in at least one of the application.”).

In view of the foregoing, it is respectfully requested that the provisional rejection of claims 4 – 6, 17 and 21 – 22 on the grounds of nonstatutory obviousness-type double patenting be held in abeyance until such time as U.S. Patent Application No. 10/557,085 issues as a patent, or until all other rejections in the present application are overcome, as outlined in the MPEP.

In the event that U.S. Patent Application No. 10/557,085 issues as a patent in advance of the present application, Applicants specifically reserve the right to file a terminal disclaimer to overcome any non-provisional obviousness-type double patenting rejections that may arise.

35 U.S.C. § 103(a) Rejections

Claims 4 – 5, 17 and 22

The Office Action has rejected Claims 4 – 5, 17 and 22 as being obvious over Jacobsen *et al.* (US 5,712,300). The Office Action stated “Jacobsen *et al.* teaches compounds of formula I which encompasses many of the compounds claimed by applicant’s formula III of Claim 4.”

Applicants have amended Claim 4 to delete the phrase “single bond or”. Claim 4 now claims Formula III with a double-bond in its ring structure [2,5-dihydro-1H-pyrrole ring].

Jacobsen ‘300 fails to disclose or suggest the compounds of Formula III or the unexpected results of anticancer effects seen by treatment with Formula III. Formula I in Jacobsen ‘300 does not disclose a double-bond in its ring structure. The disclosure of Jacobsen ‘300 would have not suggested to a person skilled in the art that it was “obvious to try” modifying the single-bond in the ring structure of Formula 1 to a double-bond. The presence of the double-bond in Formula III gives the resulting chemical unforeseen anticancer activity.

Jacobsen ‘300 fails to disclose each and every feature of Claims 4 – 5, 17 and 22 as discussed above. Moreover, the Office Action fails to provide a rationale, for modifying the teachings of Jacobsen ‘300 to remedy those deficiencies in order to arrive at the compositions of the present claims.

In view of the amendments, applicants submit that the rejection of Claims 4 – 5, 17 and 22 as being obvious over Jacobsen ‘300 has been traversed and should be withdrawn. In light of the amendments and foregoing arguments, the Examiner is respectfully requested to allow Claims 4 – 5, 17 and 22.

Rejoinder

Applicants believe the claims are now in condition for allowance, and request that the currently Withdrawn “method” claims [Claims 23 – 28] be rejoined and examined on their merit. These claims have been amended to correspond to the amendments of the composition claims currently under examination.

Applicants believe Claims 23 – 28 are in condition for allowance, and respectfully request the Examiner to allow Claims 23 – 28.

No Disclaimers or Disavowals

Although the present communication may include alterations to the claims, the Applicants are not conceding in this application that previously pending claims are not patentable. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. The Applicants reserve the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that the Applicants have made any disclaimers or disavowals of any subject matter supported by the present application.

Remarks

Claims 4 – 6, 17 and 21 – 28 are pending. Claim 4 and 5 are Currently amended. Claims 6, 17, 21 and 22 are Previously presented. Claims 23 and 24 are Currently amended – Withdrawn. Claims 25 – 28 are Previously presented – Withdrawn. Claims 1 – 3, 7 – 16 and 18 – 20 are Canceled.

Applicants respectfully request the entrance of the amendments. No New Matter was entered with these amendments.

Payment for a 3-month extension is submitted with the filing of the response. No additional fees are believed due; however, the Commissioner is authorized to charge any additional fees now and in the future which may be due, including any fees for additional extension of time, or credit overpayment to credit card information.

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